

November 3, 1995

File Memo - Ag-Bag File - '046

I called and talked to an administrator for the Interference Division of the Patent Office. He did not identify himself by name but I had asked for one of the three administrators which I understood to be Mr. Shaw, Ms. Santiago and Mr. Cashion. I am assuming that I talked to either Mr. Shaw or Mr. Cashion, probably Mr. Shaw.

I explained to him the situation as follows: The other party attempted to get claim coverage covering ABCD with a dependent claim adding element E. The broad claim was rejected. The dependent claim was considered allowable. The other party cancelled the broad claim and had a patent issued with the narrower claim, i.e., ABCDE. Prior to issuance, they filed a ^{diversified application} ~~second claim~~ *claim* with ABCD by itself and without E. It was again rejected by the Examiner. They ended up with a variation of E, i.e., they ended up with a Claim ABCDE'. My client with the same disclosure, same subject matter and pursuing the same claims went for the same claim coverage ABCD with a dependent Claim E. Again, the examiner of our case, a different examiner than the prior case, allowed Claim E, rejected Claims ABCD. At that point in time, we learned of the issuance of the first of the other party's patents and submitted a

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divisional application including ABCDE claims for interference purposes. We are pursuing in a separate case ABCD and I believe I have effectively argued around the rejection against ABCD and that I should be entitled to allowance of Claim ABCD.

The administrator indicated that as long as ABCD was patentably different than ABCDE that I was entitled to pursue ABCD independently and I had no requirement to offer it into interference. I consider that to resolve my concerns and that is the possibility of some kind of estoppel by my not having submitted ABCD as a claim for interference purposes. The administrator did, however, indicate that ^{it} was discretionary with the examiner, i.e., whether he would require ABCD as being added to the interference proceedings. My efforts hereafter will thus be to establish that ABCD and ABCDE are patentably different inventions.



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